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09/054,180 04/01/98 REISTAD

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EXAMINER

SOUGH, H

ART UNIT

PAPER NUMBER

2161

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01/24/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/054,180

Applicant(s)

REISTAD ET AL.

Examiner

Hyung S. Sough

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2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3 and 11-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 3 and 11-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on 16 December 1999 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10, 12.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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***Drawings***

1. After further review, the drawings filed on April 1, 1998 and the proposed drawing files on December 16, 1999 are objected to by the Examiner for the following reason:

- They do not comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "39" (page 22, line 20).

Applicant is advised to carefully review all the drawings for further needed corrections.

2. Applicant is required to submit a proposed drawing correction including the proposed drawing correction filed on December 16, 1999 in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

***Specification***

3. The disclosure is objected to because of the following informalities:

The specification does not contain the detailed description of the FIGS.6-12.

Applicant is advised to carefully review the entire specification for further needed corrections.

***Claim Rejections - 35 U.S.C. § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**5. Claims 3, 34, 35, 36, 37, 61, 62, and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by Sirbu et al. (Sirbu hereinafter: US PAT. 5,809,144).**

Sirbu discloses an electronic commerce system (i.e., apparatus for purchasing and delivering goods) having a client computer (10), a server computer (12 and 16) interconnected to the client computer (10) by a public packet switched communications network (i.e., Internet), wherein the client computer (10) is programed to transmit to the server computer (12 and 16) an order acceptance request comprising a plurality of terms or conditions of a proposed offer for a purchase protected by cryptographic security codes and the server computer (12 and 16) is programed to process the order acceptance request based on preprogramed criteria (i.e., negotiating step) including authentication of the cryptographic codes (see col. 1, line 61-col. 2, line 62). Further, Sirbu discloses the use of a plurality of modular elements individually protected by cryptographic security codes, i.e., Kerberos tickets which uses a particular ticket for the particular modular element (see col. 12, lines 35-39). Still further, Sirbu discloses the claimed method of processing order acceptance requests in the electronic commerce system: see col. 1, line 7-col. 2, line 62.

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***Claim Rejections - 35 U.S.C. § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 11-15, 17, 18, 20-23, 28, 38-42, 44, 45, 47-50 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Storey (US PAT. 5,774,870).**

Sirbu discloses the electronic commerce system and the method as stated supra.

- Re claims 11, 23, 38, and 50: Sirbu discloses that a credential can be issued to a customer to provide discounts to special groups (see col. 14, lines 32-36) without specifying the credential being a digital coupon. However, Storey teaches the use of a credential issued to a customer to provide discounts to special groups being a digital coupon (i.e., gift certificate) and electronically sent to a recipient without using a conventional mail (see col. 6 line 63 - col. 7, line 15). Thus, it would have been obvious to one of ordinary skill in the art to modify the system of Sirbu by adopting the teaching of Storey to deliver the digital coupon faster and to reduce the overall cost of issuing the digital coupon by eliminating the use of paper and stamp.

- Re claims 12 and 39: Sirbu teaches the use of cryptographic checksum for the credential (i.e., the digital coupon) for the security reason (see col. 14, lines 58-67). However,

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as shown by Storey, it is known to use the client computer (i.e., recipient's computer) programmed to receive the digital coupon (i.e., gift certificate) from another computer (i.e., user's computer). Thus, it would have been obvious to one of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Storey as desired to send the gift certificate faster and to reduce the overall cost of issuing the gift certificate by eliminating the use of paper and stamp.

- Re claims 13 and 40: Sirbu discloses the digital coupon (i.e., a credential) which is configured to be used by any coupon holder that possesses the digital coupon, and wherein the server computer is programmed to accept the digital coupon without regard to identity of the coupon holder (see col. 14, lines 58-61).

- Re claims 14 and 41: Sirbu states that the credential (i.e., digital coupon) may optionally be restricted for use on a specific account (see col. 14, line 58 - col. 15, line 9).

- Re claims 15 and 42: In step 1 of Sirbu, the credential (i.e., digital coupon) is presented to merchants in the price request phase of the transaction protocol.

- Re claims 17 and 44: Sirbu discloses the server computer programmed to authenticate authority of the client computer using a basis authentication method (see col. 13, lines 35-39).

- Re claims 18 and 45: Sirbu discloses the server computer programmed to authenticate authority of the client computer using a client certificate (i.e., credential containing cryptographic checksum of the account number: col. 14, line 58-67).

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- Re claims 20 and 47: Sirbu discloses the server computer programmed to set at least one term of the order acceptance based on whether the digital coupon (i.e., a credential issued to a customer) is present in the order acceptance request (see col. 15, lines 15-18)

- Re claims 21 and 48: Sirbu discloses the system having the at least one term of the order acceptance response being a price (see col. 1, lines 45-66).

- Re claims 22 and 49: Sirbu discloses the server computer programmed to set at least one term of the order acceptance response based on whether the digital coupon (i.e., a credential issued to a customer) in the order acceptance request is particular type of digital coupon (see col. 15, lines 15-20).

- Re claims 28 and 55: As shown by Storey, it is known to use the client computer (i.e., recipient's computer) programmed to receive the digital coupon (i.e., gift certificate) from another computer (i.e., user's computer). Thus, it would have been obvious to one of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Storey as desired to send the gift certificate faster and to reduce the overall cost of issuing the gift certificate by eliminating the use of paper and stamp.

**8. Claims 16 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Storey as applied to claims 15 and 42 above, and further in view of Cook (US PAT. 5,860,068).**

Neither Sirbu nor Storey explicitly discloses use of SSL connection. However, Cook teaches the use of SSL connection (see col. 2, lines 57-59) to protect the transaction of the

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sensitive information (i.e., credit card number). Thus, it would have been obvious to one of ordinary skill in the art to employ the SSL connection for the claimed system to improve the security of the system.

**9. Claims 26 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Storey as applied to claims 23 and 50 above, and further in view of Goldhaber et al. (Goldhaber hereinafter: US PAT. 5,794,210).**

- Re claims 26 and 43: Storey further teaches the electronically informing the recipient of the transaction (see col. 7, lines 8-15) without explicitly disclosing the use of an icon for the gift certificate. However, Goldhaber discloses the use of an icon for a digital coupon to facilitate the transaction of the coupon. Thus, it would have been obvious to one of ordinary skill in the art to employ the icon for the gift certificate to the claimed system and the method as taught by Goldhaber to facilitate the transaction of the coupon in the claimed system and the method.

**10. Claims 11-15, 17-22, 38-42, and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Jovicic et al. (Jovicic hereinafter: US PAT. 5,855,007).**

Sirbu discloses the electronic commerce system and the method as stated supra.

- Re claims 11 and 38: Sirbu discloses that a credential can be issued to a customer to provide discounts to special groups (see col. 14, lines 32-36) without specifying the credential being a digital coupon. However, Jovicic teaches the use of a digital coupon to attract



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customers while decreasing the amount of time and effort needed for using a conventional coupon (i.e., paper coupon: see col. 1, line 1 - col. 3, line 21). Thus, it would have been obvious to one of ordinary skill in the art to modify the system of Sirbu by adopting the teaching of Jovicic to attract customers while decreasing the amount of time and effort needed for using a conventional coupon.

- Re claims 12 and 39: Sirbu further teaches the use of cryptographic checksum for the credential (i.e., the digital coupon) for the security reason (see col. 14, lines 58-67). Jovicic further discloses the client computer (i.e., user's computer) is programmed to receive the digital coupon from another computer (i.e., Internet Coupon Server). Thus, it would have been obvious to one of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic as desired to send the gift certificate faster and to reduce the overall cost of issuing the gift certificate by eliminating the use of paper and stamp.

- Re claims 13 and 40: Sirbu discloses the digital coupon (i.e., a credential) which is configured to be used by any coupon holder that possesses the digital coupon, and wherein the server computer is programmed to accept the digital coupon without regard to identity of the coupon holder (see col. 14, lines 58-61).

- Re claims 14 and 41: Sirbu states that the credential (i.e., digital coupon) may optionally be restricted for use on a specific account (see col. 14, line 58 - col. 15, line 9).

- Re claims 15 and 42: In step 1 of Sirbu, the credential (i.e., digital coupon) is presented to merchants in the price request phase of the transaction protocol.

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- Re claims 17 and 44: Sirbu discloses the server computer programmed to authenticate authority of the client computer using a basis authentication method (see col. 13, lines 35-39).

- Re claims 18 and 45: Sirbu discloses the server computer programmed to authenticate authority of the client computer using a client certificate (i.e., credential containing cryptographic checksum of the account number: col. 14, line 58-67).

- Re claims 19 and 46: Jovicic discloses the use of serial number for the digital coupon to determine whether the digital coupon has been previously used or not (see col. 10, line 46-col. 11, line 37). Thus, it would have been within the level of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic to facilitate the step of determining whether the digital coupon has been previously used or not.

- Re claims 20 and 47: Sirbu discloses the server computer programmed to set at least one term of the order acceptance based on whether the digital coupon (i.e., a credential issued to a customer) is present in the order acceptance request (see col. 15, lines 15-18)

- Re claims 21 and 48: Sirbu discloses the system having the at least one term of the order acceptance response being a price (see col. 1, lines 45-66).

- Re claims 22 and 49: Sirbu discloses the server computer programmed to set at least one term of the order acceptance response based on whether the digital coupon (i.e., a credential issued to a customer) in the order acceptance request is particular type of digital coupon (see col. 15, lines 15-20).

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**11. Claims 23-25, 28-33, 50-52, and 55-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Jovicic as applied to claims 11 and 38 above, and further in view of Christensen et al. (Christensen hereinafter: US PAT. 5,710,886).**

- Re claims 23 and 50: Neither Sirbu nor Jovicic explicitly discloses the digital coupon being a gift certificate. However, Christensen shows that a gift certificate is an equivalent item known in the art (see the Abstract). Therefore, because these two items were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the gift certificate for the digital coupon as desired.

- Re claims 24 and 51: Jovicic discloses the use of serial number for the digital coupon to determine whether the digital coupon has been previously used or not (see col. 10, line 46-col. 11, line 37). Thus, it would have been within the level of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic to facilitate the step of determining whether the digital coupon has been previously used or not.

- Re claims 25 and 52: Jovicic discloses the server computer programmed to ensure that the serial number has been used previously by checking a database in which the serial number is stored (see col. 2, lines 47-52 and col. 10, line 46-col. 11, line 37). Thus, it would have been within the level of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic to facilitate the step of determining whether the digital coupon has been previously used or not.

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- Re claims 28 and 55: Jovicic further discloses a first client computer (i.e., vendor's computer) is programmed to receive the gift certificate from a second client computer (i.e., user's computer) (see col. 8, lines 18-22). Thus, it would have been obvious to one of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic as desired to send the gift certificate faster and to reduce the overall cost of issuing the gift certificate by eliminating the use of paper and stamp.

- Re claims 29 and 56: Jovicic further discloses the server computer (i.e., Internet Coupon server) is programmed to transmit the gift certificate (i.e., coupon) to the second client computer (i.e., user's computer), which in turn is programmed to forward the gift certificate (i.e., coupon) to the first client computer (i.e., vendor's computer) (see col. 8, lines 18-22). Thus, it would have been obvious to one of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic as desired to send the gift certificate faster and to reduce the overall cost of issuing the gift certificate by eliminating the use of paper and stamp.

- Re claims 30 and 57: Jovicic discloses the server computer (i.e., 124) programmed to create the serial number of the gift certificate before transmitting the gift certificate to the second client computer (see col. 2, lines 48-52). Thus, it would have been within the level of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic to facilitate the step of determining whether the digital coupon has been previously used or not.

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- Re claims 31 and 58: Jovicic discloses the server computer (i.e., 124 and 134) programmed to create the serial number of the gift certificate before transmitting the gift certificate to the second client computer (see col. 2, lines 48-52) and programmed to ensure check the serial number whether it has been used previously upon receiving the gift certificate from the first client computer (see col. 6, lines 24-32). Thus, it would have been within the level of ordinary skill in the art to modify the system and the method of Sirbu by adopting the teaching of Jovicic to facilitate the step of determining whether the digital coupon has been previously used or not.

- Re claims 32 and 59: Christensen further teaches the transmission of the gift certificate to the server (i.e., coupon brokerage house) before the server transmits the gift certificate to the client (see col. 12, lines 12-30). Thus, it would have been obvious to one of ordinary skill in the art to modify the claimed system and the method by adopting the teaching of Christensen as desired.

- Re claims 33 and 60: None of the cited references discloses the gift certificate is in the form of an order acceptance request that includes extension information indicating that the order acceptance request is a gift certificate. However, Official Notice is taken that making the gift certificate in the form of an order acceptance request that includes extension information indicating that the order acceptance request is a gift certificate was well-known practice to those skill in the business art at the time of applicants' invention, e.g., a gift certificate (i.e., a check) from one long distance telephone company mailed to a customer that bears information

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indicating that the order acceptance request is a gift certificate (i.e., by endorsing the back of the check to cash in, the customer will use the company that issued the check for his/her long distance telephone service).

**12. Claims 11, 13-15, 17, 18, 20-22, 38, 40-42, 44, 45, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Goldhaber.**

Sirbu discloses the electronic commerce system and the method as stated supra.

- Re claims 11 and 38: Sirbu discloses that a credential can be issued to a customer to provide discounts to special groups (see col. 14, lines 32-36) without specifying the credential being a digital coupon. However, Goldhaber teaches the use of a digital coupon to get customers' attention (see col. 4, lines 32-35 and col. 11, lines 11-15). Thus, it would have been obvious to one of ordinary skill in the art to modify the system of Sirbu by adopting the teaching of Goldhaber to get customers' attention.

- Re claims 13 and 40: Sirbu discloses the digital coupon (i.e., a credential) which is configured to be used by any coupon holder that possesses the digital coupon, and wherein the server computer is programmed to accept the digital coupon without regard to identity of the coupon holder (see col. 14, lines 58-61).

- Re claims 14 and 41: Sirbu states that the credential (i.e., digital coupon) may optionally be restricted for use on a specific account (see col. 14, line 58 - col. 15, line 9).

- Re claims 15 and 42: In step 1 of Sirbu, the credential (i.e., digital coupon) is presented to merchants in the price request phase of the transaction protocol.

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- Re Claims 17 and 44: Sirbu discloses the server computer programmed to authenticate authority of the client computer using a basis authentication method (see col. 13, lines 35-39).

- Re claims 18 and 45: Sirbu discloses the server computer programmed to authenticate authority of the client computer using a client certificate (i.e., credential containing cryptographic checksum of the account number: col. 14, line 58-67).

- Re claims 20 and 47: Sirbu discloses the server computer programmed to set at least one term of the order acceptance based on whether the digital coupon (i.e., a credential issued to a customer) is present in the order acceptance request (see col. 15, lines 15-18)

- Re claims 21 and 48: Sirbu discloses the system having the at least one term of the order acceptance response being a price (see col. 1, lines 45-66).

- Re claims 22 and 49: Sirbu discloses the server computer programmed to set at least one term of the order acceptance response based on whether the digital coupon (i.e., a credential issued to a customer) in the order acceptance request is particular type of digital coupon (see col. 15, lines 15-20).

**13. Claims 23, 26, 27, 50, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu in view of Goldhaber as applied to claims 11 and 38 above, and further in view of Christensen et al. (Christensen hereinafter: US PAT. 5,710,886).**

- Re claims 23 and 50: Neither Sirbu nor Goldhaber explicitly discloses the digital coupon being a gift certificate. However, Christensen shows that a gift certificate is an equivalent item known in the art (see the Abstract). Therefore, because these two items were

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art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the gift certificate for the digital coupon.

- Re claims 26 and 53: Goldhaber further discloses the client computer (104) programed to display an icon of the gift certificate and to initiate order acceptance request after a recipient of the gift certificate clicks on the icon (see col. 11, lines 8-44). Thus, it would have been obvious to one of ordinary skill in the art to employ the icon for the gift certificate to the claimed system and the method as taught by Goldhaber to facilitate the transaction of the coupon in the claimed system and the method.

- Re claims 27 and 54: Goldhaber further discloses a merchant computer programed to interact with the client computer by clicking on the icon (see col. 11, lines 32-38). Thus, it would have been obvious to one of ordinary skill in the art to employ the icon for the gift certificate to the claimed system and the method as taught by Goldhaber to facilitate the transaction of the coupon in the claimed system and the method.

### *Response to Arguments*

14. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

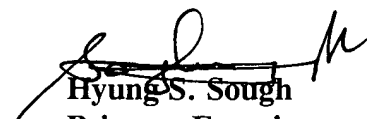
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Souh whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.



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If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax number is (703) 308-1396.



Hyung S. Souh  
Primary Examiner  
Art Unit 2161

shs  
January 22, 2001